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| 10/521,555   | 01/19/2005  | Pierre Doublet       | 052014              | 9342             |
| 38834 7590 10/07/2009<br>WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP<br>1250 CONNECTICUT AVENUE, NW<br>SUITE 700<br>WASHINGTON, DC 20036 |             |                      |                     |                  |
| EXAMINER<br>DICUS, TAMRA   |             |                      |                     |                  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
| 1794   |             |                      |                     |                  |
| NOTIFICATION DATE  |             | DELIVERY MODE        |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentmail@whda.com

### Office Action Summary

**Application No.**

10/521,555

**Applicant(s)**

DOUBLET, PIERRE

**Examiner**

TAMRA L. DICUS

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 11 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5-8, 11, 12, 15-17 and 22-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-5-8, 11-12, 15-17 and 22-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

The prior note and rejections where Zeiter is the primary reference are withdrawn.

#### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 5-8, 11-12, 15-17, and 22-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of 1-3 and 11-12 copending Application No. 10/541,202.

Although the conflicting claims are not identical, they are not patentable distinct from each other because the present claims differ only in the recitation of a more broad invention. Thus the present claims are broader in scope and encompasses that which is

claimed '202 application. This is a provisional obviousness-type double patenting rejection.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-8, 11, 15, 17, and 22-31 are rejected under 35 U.S.C. 102(e) as anticipated by US 7,429,062 to Fan et al.

Fan teaches a two-sided paper with two sets of indicia (see 16, 22 patterned lines FIGs. 2-3, in perfect registration with each other, superimposed on each side of a document, includes paper, viewed in transmitted and reflected light, wherein the second set of lines on the back or reverse side can be seen in either light dependent upon the view of the observer, if viewing the front side having the printed indicia, the observer sees through the document to the second reverse side of indicia wherein the second reverse side indicia is observed. See 1:5-15, 3:30-68, 4:1-25, and 35-65. The lines are a variety of frequencies and colors-see 3:25-30 (re claim 2-3, 5-7, 11, 15, 17, 28-31).

Because black inks, metallics (conductive) inks are used by Fan, the properties of claims 22-27 are expected to react under the claimed sources of radiation not mentioned

by Fan, see Applicant's specification on page 4, lines 12-20 only mentioning black or gray color lines reacting under different sources of radiation) to change the angle of reflection and prepares a three dimensional moiré pattern and effects when incorporating trade names and signs (see page 3, lines 18, and 31). Because the same lines and positioning are employed teaching viewing angles, resolution, straight and curved lines, and lightness to darkness effects, Fan's teaching embraces a 3D volume effect per claim 1 and varying printing intensity and density of claim 2. See page 3, lines 20–35 and page 7. The language of Fan thus addresses the limitations of the instant claims. Claims 1-3, 5-8, 11, 15, 17, and 22-31 are clearly anticipated.

*Claim Rejections – 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-8, 11-12, 15-17, and 22-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,449,200 to Andric et al.

Andric teaches a security paper with a watermark (element) and superimposed, overlapping, and identical indicia in accurate registration on both sides that is observed in reflected light and viewed in transmitted light (18 and 20 in registration with each other or similarly, 18 and 22, which follows that 20 and 22 are in registration with each other, Figs. 1-2 and associated text, 12:1-35) on a paper support (10, Fig. 1), where the images are numerals, words, or symbols in any number combination (9:1-10, embraces dots, alternating, varying). Both sets of lines form an image observed in transmitted light (see 10:15-20). Regions 40, 42, 44, 46, 48 (Fig. 1) are transparent (thus including a region of reduced opacity as per instant claim 12). Also Fig. 2 teaches a similar paper, including any pigments to increase opacity. The images are printed using transparent, non-transparent, fluorescent or magnetic inks (13:1-15, same material as magnetic so the excitation what happens under excitation sources are inherent properties). When using transparent ink, the indicia cannot be observed in reflected light when photocopying (see 9:51+). Opaque ink or non-transparent ink is also used for 18, wherein the indicia are visible in transmitted light (see 9:28-30). Opaque regions are taught to change how indicia are viewed (see 9:20-30, 10:55-68, see further FIG. 1, and 11:29-68) describing opaque regions: 54, 56 and transparent regions: 40, 42, 44, 46, 48). The language of Andric thus addresses the limitations of instant Claims 1-3, 5-8, 11-12, 15-17, and 21-27 in part.

Andric does not teach the exact language of indicia are (or when) observed in transmitted light or having the appearance of a three-dimensional image volume or relief effect with varying density (Claims 1-3, 5-8, 11-12, 17 and 28-30).

However, the lines and image inherently form a 3D effect because the effect is “created by the planar arrangement of the first and second set of lines” as claimed.

Further while Andric does not teach set of indicia 20 and 22 visible in transmitted light, Andric teaches indicia 18 is viewed in this way (9:25-30) and already teaches incorporating transparent ink of 18 for 20 and 22 (see 10:15-20), and thus using opaque ink to create the effect of being viewed in transmitted light, is an obvious feature as one having skill in the art would look to what is already supplied by Andric (e.g. the opaque ink forming indicia viewed in transmitted light) and use it in the indicia, as already suggested when using transparent ink -10:15-20, for creating lines visible in transmitted light. Further Andric does not preclude opaque inks in 18, and 22 and thus does not teach away from this obvious application. Further note: Though we are fully cognizant of the hindsight bias that often plagues determinations of obviousness, Graham v. John Deere Co., 383 U.S. 1, 36 (1966), we are also mindful that “the combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results,” KSR Int’l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1739 (2007). Since the lines are similarly arranged, have a multi-tone effect, made with a mask, it would have been obvious to recognize the similarities, resulting in

the variety of visual effects claimed because Andric teaches them on both sides and thus in combination the invention is envisaged.

Claims 12 and 16 are rejected under 35 U.S.C. 103(a) as obvious over US 7,429,062 to Fan et al. in view of Andric.

Fan essentially teaches the claimed invention above.

Fan doesn't teach regions of reduced opacity as claimed.

However, Andric, analogously directed, shows this feature as recited above. Herein the teachings of Andric are repeated below.

Regions 40, 42, 44, 46, 48 (Fig. 1) are transparent (thus including a region of reduced opacity as per instant claim 12). Also Fig. 2 teaches a similar paper, including any pigments to increase opacity. The images are printed using transparent, non-transparent, fluorescent or magnetic inks (13:1-15, same material as magnetic so the excitation what happens under excitation sources are inherent properties). When using transparent ink, the indicia cannot be observed in reflected light when photocopying (see 9:51+). Opaque ink or non-transparent ink is also used for 18, wherein the indicia are visible in transmitted light (see 9:28-30). Opaque regions are taught to change how indicia are viewed (see 9:20-30, 10:55-68, see further FIG. 1, and 11:29-68) describing opaque regions: 54, 56 and transparent regions: 40, 42, 44, 46, 48).



It would have been obvious to one having ordinary skill in the art to have modified the paper support of Fan (see 3:35-40) to include regions of reduced opacity as claimed because Andric teaches such features aid in preventing forgery as cited above.

Claims 22-27 are rejected under 35 U.S.C. 103(a) as obvious over US 7,429,062 to Fan et al. view of Andric.

Fan essentially teaches the claimed invention above.

Fan doesn't teach properties as claims 22-27 recite.

Andric teaches inks including phosphorescent, magnetic, or fluorescent inks wherein the indicia are excited under ultra violet light (see 9:40-68; 10:1-30) to change the viewing and adding further security features of the indicia.

It would have been obvious to one having ordinary skill in the art to have modified Fan to include the variety of properties because Andric teaches such inks that inherently have said properties are well known for adding additional security features as cited above.

### ***Response to Arguments***

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Applicant did not present arguments regarding the primary reference Andric, and thus the Examiner's reasoning stands as set forth above.

Further in regards to what is claimed, Applicant doesn't state in the present claims as argued that "only the set of lines on the viewing side is visible", which seem quite different to what is actually claimed "visible... from any of the front and the reverse sides". Further the claims don't require both sets of first and second lines to be on each side (both front and reverse), if that is what Applicant intends.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAMRA L. DICUS whose telephone number is (571)272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Ruthkosky can be reached on 571-272-1291. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tamra L. Dicus /TLD/  
Examiner  
Art Unit 1794

September 28, 2009

/Bruce H Hess/  
Primary Examiner, Art Unit 1794